

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHAO-HUA GUO, WEI WANG
and DANIEL B. POURREAU

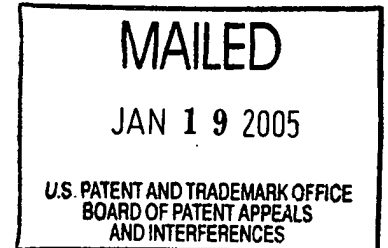
Appeal No. 2005-0225
Application No. 09/934,878

ON BRIEF

Before WARREN, KRATZ and DELMENDO, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we determine that the above-identified application is not ready for a decision on appeal under 35 U.S.C. § 134 (2003). Accordingly, we remand this application to the examiner for further consideration and action not inconsistent with our opinion below. 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).



Appellants argue, inter alia, that the examiner has not made out a prima facie case of obviousness, in part, because the combined teachings of the relied upon references, as proposed by the examiner, would not be attended by a reasonable expectation of success (brief, pages 5 and 6). In support of this argument, appellants rely on an exhibit attached to the appeal brief, namely selected excerpts from Principles of Polymerization by George Odian.

The examiner, on the other hand, does not comment on whether this evidence has been entered and considered.

At the time of filing the brief, 37 CFR § 1.195 (2003) (effective Nov. 26, 1969) stated: "Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented." See also MPEP § 1208 (Aug. 2001).¹

¹ The record reflects that Odian was first referenced by appellants at page 8 of a reply filed September 29, 2003, which was contemporaneous with the filing of a Notice of appeal on the same date. However, the electronic application file record does not reflect that a copy of the referenced pages from the work of Odian accompanied that reply. Moreover, the examiner makes no specific mention of the entry status of Odian in the advisory action mailed November 18, 2003.

It is clear, therefore, that the examiner's failure to comment on the newly submitted evidence was not in accordance with applicable patent practice and procedure. To correct this deficiency, the examiner must clarify whether the submission of the evidence complied with the provisions of 37 CFR § 1.195 and, if so, clearly indicate whether the evidence has been entered and considered. If the appellants' arguments regarding this evidence are unpersuasive, the examiner must provide reasons in support of such a determination.

On return of this application, the examiner should take appropriate action to correct the deficiencies identified above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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